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09/802,354	03/09/2001	Steven A. Sunshine	18564I008110	7440

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EXAMINER	
O CONNOR, GERALD J	
ART UNIT	**PAPER NUMBER**
3627	9

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/802,354	Applicant(s) Sunshine et al.
	Examiner O'Connor	Art Unit 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *January 13, 2004 (Response to Req't for Restriction)* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-55* is/are pending in the application.

4a) Of the above, claim(s) *9-55* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Invention I (Claims 1-8) in Paper № 7 is hereby acknowledged. The traversal is only with respect to restriction between Inventions I and IV, on the ground(s) that both inventions could be examined without serious burden on the examiner.

2. Applicant's arguments have been fully considered but are not found persuasive.

3. Regarding "serious burden" MPEP § 803 states, in part, under "Guidelines":

> A serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.

4. As the examiner has indeed made such a *prima facie* showing of serious burden, based upon separate classification, as set forth in the Requirement for Restriction (Paper № 5), and as applicant has offered no "showing or evidence" in rebuttal to that conclusion, simply an opinion stating a contrary position, applicant's arguments have been dismissed as merely spurious, amounting to simply a general allegation that a serious burden would not be imposed, without specifically pointing out how the language of the claims fails to comport with the explanation of separate classification provided by the examiner.

5. The restriction requirement is still deemed proper and is therefore made FINAL.

6. Claims 9-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper Nº 7.

Information Disclosure Statement

7. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

8. Claim 6 is objected to because of the following informality: it appears that "according to claim 1" was intended to be --according to claim 5--, which change will be assumed for purposes of further consideration of the claim hereinafter. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e)[1] the invention was described in-
>
> > (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> >
> > (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolawa et al. (US 6,370,513).

Kolawa et al. disclose a system for recommending a consumer product selection across a network, the system comprising: a recommendation engine comprising a first module (portion of functional descriptive material) for determining a difference between a plurality of consumer products having a plurality of descriptors by differentiating between at least one descriptor of the consumer products and providing the difference to a computer module; a second module (portion

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[1] The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

of functional descriptive material) coupled to the recommendation engine for sorting between each of the consumer products to form at least two classes of the consumer products; a third module (portion of functional descriptive material) coupled to the recommendation engine for determining, for each consumer product, a correlation between the at least two classes and each of the descriptors, assigning a weighting term for each descriptor based upon the ability of each descriptor to sort between the at least two classes; and, a fourth module (portion of functional descriptive material) coupled to the recommendation engine for cooperatively operating on the weighting terms to provide a recommendation.

Regarding claims 2-3, the nature of the particular consumer product being recommended by the system (wine, perfume, etc.) has been deemed merely a "for use" application of the claimed invention, hence, afforded little patentable weight (Kolawa et al. do, however, disclose a wine embodiment).

Regarding claim 4, each of the descriptors of the system of Kolawa et al. is (inherently) either an intrinsic (non-extrinsic) descriptor or an extrinsic (non-intrinsic) descriptor.

Regarding claims 5-6, each of the descriptors of the system of Kolawa et al. is in digital format, and is (inherently) either streaming (non-static) or static (non-streaming).

Regarding claim 7, the system of Kolawa et al. utilizes cluster mapping to generate the correlations between the consumer products and the at least two classes (see, in particular, column 12, line 35, to column 13, line 14).

Regarding claim 8, the network 12 of the system of Kolawa et al. is the Internet.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC
February 9, 2004

(2-9-04)

Gerald J. O'Connor
Patent Examiner
Group Art Unit 3627